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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,738	06/24/2005	Yoshiyuki Ebihara	89394.010100	2918

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GREENBERG TRAURIG, LLP
77 WEST WACKER DRIVE
SUITE 2500
CHICAGO, IL 60601-1732

EXAMINER

BRAKEWOOD, CANDACE ELIZABETH

ART UNIT	PAPER NUMBER
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3721

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/540,738

Applicant(s)

EBIHARA, YOSHIYUKI

Examiner

Candace Brakewood

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/16/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The information disclosure statement filed November 16, 2005 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. Therefore, the JP Patent Publication 63-186575 has not been considered. Additionally, JP -A-62-218080 and JP-A-63-47076, which were discussed in the specification, were not included on the Information Disclosure Statement, nor was a copy of these patents included. Therefore, they have not been considered. Lastly, the non-patent literature from e-TOP Co., Ltd. was not listed on the Information Disclosure Statement, as it should be, but the submitted e-TOP Co., Ltd. was considered in the examination process.

Drawings

3. Fig. 49 and Fig. 57 are not of sufficient quality to permit examination. Accordingly, replacement drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to this Office action. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. Applicant is given a TWO MONTH time period to submit new drawings in compliance with 37 CFR 1.81. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a). Failure to timely submit replacement drawing sheets will result in ABANDONMENT of the application.

4. Figures 59, 60, 61, 62, 63 and 64 should be designated by a legend such as -- Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to because the Figure designation is not in English. Please include the word --Figure- or --Fig.- with each drawing. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief

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description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. Applicant is reminded of the proper language and format for an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The abstract of the disclosure is objected to because it is more than 150 words. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the structural limitations of the phrase "in case the sections of X-Y directions of a portion forming said top side portion, a portion forming said bottom side portion, a portion forming said right side portion, a portion forming said left side portion, a portion forming said front side portion, a portion forming said back side portion and a portion forming said staple guide member are projected in one virtual plane in the X-Y directions, the section of one portion in the X-Y directions and the section of another portion in the X-Y directions are absent over each other in a Z-direction" are unclear and indefinite. Specifically, the use of the phrase "in case" implies that this is not a requirement for the claim. Additionally, the use of the term "virtual" is indefinite. Lastly, claim 1 recites the limitations "the sections of X-Y directions", "the section of one portion in the X-Y directions" and "the section of another portion in the X-Y directions". There are insufficient antecedent bases for these limitations in the claim, and it is unclear to which portions these limitations refer.

Claim 2 recites the limitations "the sections of X-Y directions", "the section of one portion in the X-Y directions" and "the section of another portion in the X-Y directions". There are insufficient antecedent bases for these limitations in the claim.

Claim 3 recites the limitations “the section of the X-Y directions of a portion forming said staple guide member”, “the section of a portion forming said staple guide member in the X-Y directions” and “the section of said another portion in the X-Y directions”. There are insufficient antecedent bases for these limitations in the claim. Additionally, the difference between the phrases “the section of the X-Y directions of a portion forming said staple guide member” and “the section of a portion forming said staple guide member in the X-Y directions” is unclear.

Claim 5 recites the limitations “the sections of X-Y directions of a portion forming said top side portion”, “the section of one portion in the X-Y directions” and “the section of another portion in the X-Y directions”. There are insufficient antecedent bases for these limitations in the claim.

Claim 6 recites the limitation “said feeder member”. There is insufficient antecedent basis for this limitation in the claim; specifically, the use of the term “member” was not previously recited.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-6 and 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Beecroft (2,632,889). Beecroft ('889) discloses a stapler having a holder member (Fig. 11) including a top side portion, bottom side portion, right side portion, left side portion,

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front side portion and a back side portion (Fig. 11 and Fig. 12). Beecroft ('889) further discloses a staple guide member (32) inside of and extending in the axial direction of the holder member (Fig. 12).

Regarding claim 1, it should be noted that there is a hole (42) in the left side portion of the holder member, and another hole (23) in the top side portion of the holder member. Therefore, due to the indefinite nature of the "sections" of the portions in the X-Y directions, the holder member is deemed to have sections absent over each other in a Z-direction.

Regarding claim 2, as previously stated, Beecroft ('889) discloses a holder member (Fig. 11) including a top side portion, bottom side portion, right side portion, left side portion, front side portion and a back side portion (Fig. 11 and Fig. 12). Additionally, the back wall of the cassette (20) is deemed to be the holder spring engaging member because it engages the spring (24, Fig. 12). Again, as previously stated, because there is a hole (42) in the left side portion and another hole (23) in the top side portion, the holder member is deemed to have sections absent over each other in a Z-direction.

Regarding claim 3, staple guide member (32) is inside of the holder member and extends in the axial direction (Fig. 12). It should also be noted that the holder member and staple guide member are deemed to be integral with each other because they are parts of a whole and function as a unit. Lastly, because the staple guide member (32) does not extend down the entire length of the top and bottom side portions of the

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cassette (20), a section of the staple guide member is deemed absent over another section in the Z-direction.

Regarding claim 4, the ears (25) are deemed to be a spring guide, located inside of said holder structure (Fig. 14), because the ears (25) guide the spring (24) to engage the staples.

Regarding claim 5, as previously stated, Beecroft ('889) discloses a holder member (Fig. 11) including a top side portion, bottom side portion, right side portion, left side portion, front side portion and a back side portion (Fig. 11 and Fig. 12). Additionally, the back wall of the cassette (20) is deemed to be the holder spring engaging member because it engages the spring (24, Fig. 12). As previously stated, a staple guide member (32) is inside of the holder member and extends in the axial direction (Fig. 12), and the holder member and staple guide member are deemed to be integral with each other because they function as a unit. It should also be noted that the feeder includes a feeder spring engaging member (the ears – 25) and a spring (24, column 3, lines 33-38).

With regards to claim 6, staples (21) are pushed forward by the feeder to slide along the staple guide (32, column 3, lines 33-57) before they are ejected from the stapler.

Regarding claim 9, the spring (24) is a push spring.

With regards to claim 10 and 11, the staple guide member (32) supports both the top backs and the legs of the staples (Fig. 12, Fig. 13, Fig. 15).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beecroft (2,632,889) in view of Salleras Escalante (4,405,073). Beecroft ('889) discloses the invention substantially as claimed, except for the use of a tension spring engaged with a spring guide to form a U-letter shape. Salleras Escalante teaches the use of a tension spring (44) engaged with a spring guide (42) to form a U-letter shape (Fig. 2). This spring arrangement is used for the purpose of lowering forces in the stapling process (column 2, lines 15-25). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention is use a tension spring engaged with a spring guide to form a U-letter shape in order to reduce the forces needed for the stapling process.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ebihara (4,607,777), Ebihara (4,756,462), Ebihara (4,784,307), Ebihara (4,717,062), Ebihara (7,066,370), Brown (7,059,509), Lee (6,672,499), Tegtmeier (5,427,298), Goodstein (2,501,564), Bates (1,735,195) and Forrester (2,795,786) are cited to show related inventions.

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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Candace Brakewood whose telephone number is 571-272-3115. The examiner can normally be reached on Monday-Thursday, 7am-5:30pm.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



CEB
Candace Elizabeth Brakewood
Examiner
Art Unit 3721
December 28, 2006



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700